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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,754	07/01/2003	Thomas W. Mower	14564.37.1	5557

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EXAMINER

SHEIKH, HUMERA N

ART UNIT	PAPER NUMBER
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1618

MAIL DATE	DELIVERY MODE
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07/22/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/612,754

Applicant(s)

MOWER ET AL.

Examiner

Humera N. Sheikh

Art Unit

1618

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12, 20 and 23-29 is/are pending in the application.
- 4a) Of the above claim(s) 13-19, 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12, 20 and 23-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB08)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Status of the Application

Receipt of the Response after Non-Final Office Action, the Amendment and Applicants Arguments/Remarks, all filed 04/03/08 is acknowledged.

Claims 1-29 are pending in this action. Claims 1, 7, 20 and 23 have been amended. New claims 24-29 have been added. Claims 13-19, 21 & 22 have previously been withdrawn. Claims 1-12, 20 and 23-29 remain rejected.

* * * * *

Claim Rejections - 35 USC § 103

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-12, 20 and 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Su *et al.* (U.S. Patent Publication No. 2002/0068102 A1) in view of Fischer *et al.* (U.S. Patent No. 5,433,965) OR Downton *et al.* (U.S. Patent No. 5,411,755).

The instant invention is drawn to a dietary supplement comprising: noni fruit; Luo Han Guo powder in a range from about 0.001 percent to about 3 percent by weight of the dietary supplement to mask flavor and/or scent of the noni fruit; Luo Han Guo liquid extract; and water.

The instant invention is also drawn to a method of improving the taste and odor of noni-based dietary supplements, comprising: providing a noni fruit product; and mixing with the noni fruit product Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit;

the Luo Han Guo including: powdered Luo Han Guo extract in a range from about 0.001 percent to about 3 percent by weight of the dietary supplement; and liquid Luo Han Guo extract; whereby the powdered Luo Han Guo extract provides a masking effect to cover the unpleasant tastes and/or odors of the noni and the liquid Luo Han Guo acts as a sweetener for the dietary supplement.

The instant invention is also drawn to a method of improving the taste and odor of a noni-based dietary supplement, while simultaneously prolonging the shelf life thereof, comprising: providing a noni-based fruit product; mixing with the noni fruit product: liquid Luo Han Guo extract in an effective amount to sweeten the supplement; powdered Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit, wherein the effective amount is in a range from about 0.001 percent to about 3 percent by weight of the dietary supplement; raspberry fruit concentrate; and blueberry fruit concentrate.

Su *et al.* ('102) teach a dietary supplement to reduce cellular damage within the human body, whereby the dietary supplement includes reconstituted *Morinda citrifolia* (noni) fruit juice. The dietary supplement may also include other natural juices, such as natural blueberry juice concentrate and/or another natural juice concentrate. In one implementation, where liquid is extracted from the fruit of *Morinda citrifolia* to create the dietary supplement, it is referred to as 'Tahitian Noni' (see Abstract); (page 1, ¶ 13); (pg. 3, ¶ 28).

Su *et al.* teach that when the *Morinda citrifolia* fruit is ripe or overripe, the fruit provides a foul odor and/or taste (pg. 2, ¶ 25).

To prepare the supplement, *Morinda citrifolia* juice and puree are typically blended in a homogeneous blend, after which they are mixed with other ingredients, such as flavorings, sweeteners, nutritional ingredients, botanicals, extracts, and/or colorings. For example, flavorings may include artificial and/or natural flavor or ingredients that contribute to palatability. Sweeteners taught include natural sugars, artificial and high-intensity sweeteners. Specific sweeteners taught include natural sugars derived from corn, sucralose, stevia, saccharin, etc. (pg. 3, ¶ 35).

Consumption amounts of the dietary supplement may include more than one ounce per day or less than one ounce per day (pg. 1, ¶ 15 – pg. 2 ¶ 15).

With regard to the instant ‘method of improving taste and odor’ of noni based dietary supplements, it is the position of the Examiner that the instant method would be considered *prima facie* obvious based on the disclosure and teachings of Su *et al.*, as Su *et al.* teach a noni-based (*Morinda citrifolia*) dietary supplement that comprises at least one of flavorings and sweeteners (see for instance, Claim 13).

While Su *et al.* do not explicitly teach the instant amounts of noni fruit, the Examiner points out that, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” In re Aller, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It is the Examiner’s position that Applicants have not demonstrated any surprising or unexpected results that accrue from the

claimed amounts of noni fruit. The prior art clearly recognizes and teaches formulations based on noni fruit, particularly, *Morinda citrifolia*, used in dietary supplement formulations.

Su et al. as discussed above, teach that *Morinda citrifolia* provides a foul odor and/or taste when ripe or overripe. *Su et al.* also teach that flavoring agents, sweetening agents and the like are added in the supplement to contribute to palatability.

Su et al. do not teach inclusion of Luo Han Guo and raspberry concentrate.

Fischer et al. ('965) teach beverage and sweetening compositions comprising Luo Han Guo. The Luo Han Guo is provided in serum, puree or juice form and is used as a sweetening ingredient in place of sugar (see reference column 1, line 25 – col. 2, line 46). The use of Luo Han Guo allows for good tasting, storage-stable beverages and can be used in beverages, such as fruit juices and fruit juice-containing beverages (col. 2, lines 29-35). Luo Han Guo provides for a reduced calorie, flavoring system that has acceptable mouth feel and taste characteristics, particularly, a beverage without off-flavors (col. 2, lines 47-62); (col. 12, lines 27-30).

The Luo Han Guo-containing sweet juices can be concentrated but are mostly used as a single strength juice or as a dry powder (col. 4, lines 20-40).

Luo Han Guo is preferably present at an amount of from 0.25 to 10% (col. 10, lines 27-36). See also Examples on cols. 16-19. This amount is an overlapping amount, which reads on the instantly claimed amount of from about 0.1% to about 3%, as in claim 2.

Flavoring agents that can be used include raspberry, blueberry and the like (col. 4, lines 4-19); (col. 11, lines 44-59). The flavoring agents are provided in amounts of from 0.01% to 3% by weight (col. 11, lines 26-32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Luo Han Guo and raspberry flavorants as taught by Fischer *et al.* within the dietary supplement of Su *et al.* One of ordinary skill in the art would be motivated to do so with a reasonable expectation of success because Fischer *et al.* teach a high-intensity sweetener, Luo Han Guo and teach that it is used as a sweetening agent, useful for providing good taste, with acceptable mouth feel and taste characteristics and also teach that additional flavorants and juices include raspberry to make low calorie beverages. The expected result would be an improved, palatable, reduced-calorie dietary supplement formulation.

With regard to the instantly claimed extraction amounts of Luo Han Guo and/or ORAC values, it is the position of the Examiner that it is deemed obvious to one of ordinary skill in the art to determine suitable or effective amounts and/or values through the use of routine or manipulative experimentation to obtain the best possible results, as these are indeed variable parameters attainable within the art. Absent a showing of unexpected results that accrue from the instant amounts/values, the instant amounts/values would be determined by the normal optimization process by the skilled artisan.

The teachings of Su *et al.* are discussed above. Su *et al.* teach that *Morinda citrifolia* provides a foul odor and/or taste when ripe or overripe. Su *et al.* also teach that flavoring agents, sweetening agents and the like are added in the supplement to contribute to palatability.

Su *et al.* do not teach inclusion of Luo Han Guo and raspberry concentrate.

Downton *et al.* ('755) teach a sweet juice composition comprising Luo Han Guo. The sweet fruit juice and concentrate can be made from Luo Han Guo juice so that it does not contain objectionable off-flavors and does not reform substantial quantities of off-flavors during storage (see reference column 2, lines 1-26); (col. 3, lines 3-15) and Examples at cols. 12-15. An objective is to also produce a fruit juice, which is lower in sugar and calories by blending the very sweet (Luo Han Guo) juice with other fruit juices (col. 2, lines 27-30). Other suitable fruit juices disclosed include raspberry fruit juices (col. 10, lines 30-50). The sweet juice has a pH of less than about 4.5 (claim 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Luo Han Guo and raspberry juices as taught by Downton *et al.* within the dietary supplement of Su *et al.* One of ordinary skill in the art would be motivated to do so with a reasonable expectation of success because Downton *et al.* teach a natural sweetener, Luo Han Guo, whereby the sweet fruit juice and concentrate can be made from Luo Han Guo juice so that it does not contain objectionable off-flavors and does not reform substantial quantities of off-flavors during storage and also teach that additional fruit juices, such as raspberry are included in the Luo Han Guo juice to make low calorie (lower sugar) beverages.

The expected result would be an enhanced, palatable, low-caloric dietary supplement formulation.

With regard to the instantly claimed extraction amounts of Luo Han Guo and/or ORAC values, it is the position of the Examiner that it is deemed obvious to one of ordinary skill in the art to determine suitable or effective amounts and/or values through the use of routine or manipulative experimentation to obtain the best possible results, as these are indeed variable parameters attainable within the art. Absent a showing of unexpected results that accrue from the instant amounts/values, the instant amounts/values would be determined by the normal optimization process by the skilled artisan.

While the references do not explicitly teach the recited ranges or amounts (about 0.001 to about 3% Luo Han Guo powder) as claimed in instant claims 1, 20 and 23-29, the reference nonetheless recognize the use of the same components in combination to yield the same results as desired by Applicant. Moreover, Applicant has not demonstrated any superior or unexpected results that accrue from the claimed amounts. The determination of suitable or effective amounts is within the level of one of ordinary skill in the art.

With regards to the amendment to claim 1, Applicants have provided a product-by-process claim. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

* * * * *

Claims 1-12, 20 and 23-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yegorova (U.S. Patent No. 6,387,370 B1) in view of Fischer *et al.* (U.S. Patent No. 5,433,965) OR Downton *et al.* (U.S. Patent No. 5,411,755).

The instant invention is drawn to a dietary supplement comprising: noni fruit; Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit; and water; wherein the dietary supplement is prepared by combining noni fruit with a powdered extract of Luo Han Guo.

The instant invention is also drawn to a method of improving the taste and odor of noni-based dietary supplements, comprising: providing a noni fruit product; and mixing with the noni fruit product Luo Han Guo in an effective amount to mask flavor and/or scent of the noni fruit; the Luo Han Guo including: powdered Luo Han Guo extract; and liquid Luo Han Guo extract; whereby the powdered Luo Han Guo extract provides a masking effect to cover the unpleasant tastes and/or odors of the noni and the liquid Luo Han Guo acts as a sweetener for the dietary supplement.

The instant invention is also drawn to a method of improving the taste and odor of a noni-based dietary supplement, while simultaneously prolonging the shelf life thereof, comprising: providing a noni-based fruit product; mixing with the noni fruit product: liquid Luo Han Guo extract in an effective amount to sweeten the supplement; powdered Luo Han Guo in an effective

amount to mask flavor and/or scent of the noni fruit; the Luo Han Guo including powdered Luo Han Guo; liquid Luo Han Guo; raspberry fruit concentrate; and blueberry fruit concentrate.

Yegorova (*370) teaches dietary supplement compositions that include extracts of *Morinda citrifolia*, also called Noni juice, and blueberry extracts (see Abstract); (col. 5, lines 22-26); (col. 6, line 66 – col. 7, line 10).

The preparations may be in solid form, such as a capsule, powder or granule, or a tablet form. Alternatively, the compositions may be dispersed into a suitable liquid. The composition may also be administered orally, preferably two to three times daily (col. 5, lines 14-20); (col. 11, lines 46-56).

The composition may comprise *Morinda citrifolia* extract in an amount ranging from about 50 mg to about 150 mg and blueberry extract in an amount ranging from about 25 mg to about 75 mg (col. 4, lines 21-34); (col. 7, lines 35-42); (col. 8, lines 62-66).

In a preferred embodiment, the compositions may comprise 100 mg of *Morinda citrifolia* extract obtained by extracting the *Morinda citrifolia* fruit with water (col. 8, lines 1-7).

According to Yegorova, compositions comprising blueberry extract have been used to retard the aging process, as blueberries comprise large amounts of antioxidants. Blueberries rank in the top five of an antioxidant assay called ORAC (oxygen radical absorbance capacity) (col. 7, lines 7-10); (col. 8, lines 31-66).

Example 1 at columns 12-13 demonstrates a composition that includes *Morinda citrifolia* (100 mg) and blueberry extract (50 mg).

While Yegorova does not explicitly teach the instantly claimed amounts of noni fruit, the Examiner points out that, generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. “[W]here the general conditions of a claim are disclosed in the prior art, it is not inventive to discover the optimum or workable ranges by routine experimentation.” *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955). It is the Examiner’s position that Applicants have not demonstrated any surprising or unexpected results that accrue from the claimed amounts of noni fruit. The prior art clearly recognizes and teaches dietary formulations based on noni fruit, particularly, *Morinda citrifolia* in combination with antioxidant-containing blueberry extract.

Yegorova does not teach inclusion of Luo Han Guo and raspberry concentrate.

Fischer *et al.* (‘965) teach beverage and sweetening compositions comprising Luo Han Guo. The Luo Han Guo is provided in serum, puree or juice form and is used as a sweetening ingredient in place of sugar (see reference column 1, line 25 – col. 2, line 46). The use of Luo Han Guo allows for good tasting, storage-stable beverages and can be used in beverages, such as fruit juices and fruit juice-containing beverages (col. 2, lines 29-35). Luo Han Guo provides for a reduced calorie, flavoring system that has acceptable mouth feel and taste characteristics, particularly, a beverage without off-flavors (col. 2, lines 47-62); (col. 12, lines 27-30).

The Luo Han Guo-containing sweet juices can be concentrated but are mostly used as a single strength juice or as a dry powder (col. 4, lines 20-40).

Luo Han Guo is preferably present at an amount of from 0.25 to 10% (col. 10, lines 27-36). See also Examples on cols. 16-19. This amount is an overlapping amount, which reads on the instantly claimed amount of from about 0.1% to about 3%, as in claim 2.

Flavoring agents that can be used include raspberry, blueberry and the like (col. 4, lines 4-19); (col. 11, lines 44-59). The flavoring agents are provided in amounts of from 0.01% to 3% by weight (col. 11, lines 26-32).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Luo Han Guo and raspberry flavorants as taught by Fischer *et al.* within the dietary supplement of Yegorova. One of ordinary skill in the art would be motivated to do so with a reasonable expectation of success because Fischer *et al.* teach a high-intensity sweetener, Luo Han Guo and teach that it is used as a sweetening agent, useful for providing good taste, with acceptable mouth feel and taste characteristics and also teach that additional flavorants and juices include raspberry to make low calorie beverages. The expected result would be an improved, palatable, reduced-calorie dietary supplement formulation.

With regard to the instantly claimed extraction amounts of Luo Han Guo and/or ORAC values, it is the position of the Examiner that it is deemed obvious to one of ordinary skill in the art to determine suitable or effective amounts and/or values through the use of routine or manipulative experimentation to obtain the best possible results, as these are indeed variable parameters attainable within the art. Absent a showing of unexpected results that accrue from the instant amounts/values, the instant amounts/values would be determined by the normal optimization process by the skilled artisan.

The teachings of Yegorova are delineated above.

Yegorova do not teach Luo Han Guo and raspberry concentrate.

Downton *et al.* ('755) teach a sweet juice composition comprising Luo Han Guo. The sweet fruit juice and concentrate can be made from Luo Han Guo juice so that it does not contain objectionable off-flavors and does not reform substantial quantities of off-flavors during storage (see reference column 2, lines 1-26); (col. 3, lines 3-15) and Examples at cols. 12-15. An objective is to also produce a fruit juice, which is lower in sugar and calories by blending the very sweet (Luo Han Guo) juice with other fruit juices (col. 2, lines 27-30). Other suitable fruit juices disclosed include raspberry fruit juices (col. 10, lines 30-50). The sweet juice has a pH of less than about 4.5 (claim 18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the Luo Han Guo and raspberry juices as taught by Downton *et al.* within the dietary supplement of Yegorova. One of ordinary skill in the art would be motivated to do so with a reasonable expectation of success because Downton *et al.* teach a natural sweetener, Luo Han Guo, whereby the sweet fruit juice and concentrate can be made from Luo Han Guo juice so that it does not contain objectionable off-flavors and does not reform substantial quantities of off-flavors during storage and also teach that additional fruit juices, such as raspberry are included in the Luo Han Guo juice to make low calorie (lower sugar) beverages. The expected result would be an low-calorie dietary supplement composition that offers improved taste and flavoring.

With regard to the instantly claimed extraction amounts of Luo Han Guo and/or ORAC values, it is the position of the Examiner that it is deemed obvious to one of ordinary skill in the

art to determine suitable or effective amounts and/or values through the use of routine or manipulative experimentation to obtain the best possible results, as these are indeed variable parameters attainable within the art. Absent a showing of unexpected results that accrue from the instant amounts/values, the instant amounts/values would be determined by the normal optimization process by the skilled artisan.

While the references do not explicitly teach the recited ranges or amounts (about 0.001 to about 3% Luo Han Guo powder) as claimed in instant claims 1, 20 and 23-29, the reference nonetheless recognize the use of the same components in combination to yield the same results as desired by Applicant. Moreover, Applicant has not demonstrated any superior or unexpected results that accrue from the claimed amounts. The determination of suitable or effective amounts is within the level of one of ordinary skill in the art.

With regards to the amendment to claim 1, Applicants have provided a product-by-process claim. “[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

* * * * *

Pertinent Art

Prior art not relied upon but deemed relevant by Examiner:

- **Xiong *et al.*** (U.S. Patent No. 6,299,925 B1):

Xiong *et al.* teach a green tea extract formulation comprising Noni fruit, obtained from *Morinda citrifolia* plant. The formulation also contains fruit extracts, such as blueberry and raspberry extract (see Abstract; col. 6, lines 61-65; col. 8, Example VII; and Claim 23).

- **Pushpangadan *et al.*** (U.S. Patent No. 7,014,872):

Pushpangadan *et al.* teach an herbal nutraceutical formulation comprising a plant product composition of *Momordica charantia* (see claims).

Response to Arguments

Applicant's arguments filed 04/03/08 have been fully considered but they are not persuasive.

35 U.S.C. §103(a) Rejections of claims 1-12, 20 and 23 over Su *et al.* (U.S. Patent Publication No. 2002/0068102 A1) in view of Fischer *et al.* (U.S. Patent No. 5,433,965) OR Downton *et al.* (U.S. Patent No. 5,411,755) and Yegorova (U.S. Pat. No. 6,387,370) in view of Fischer *et al.* (U.S. Patent No. 5,433,965) OR Downton *et al.* (U.S. Patent No. 5,411,755):

Applicant argued, "It is clear that when Fischer *et al.* use the term 'dried powders' they are not discussing powdered Luo Han Guo made from whole fruit and are instead discussing a dried sweet juice and not the use of unrefined, dried Luo Han Guo as taught in the present application. Fischer are not advocating using the powder made from dried Luo Han Guo when they refer to dry powders in column 4, lines 39-40."

Applicant's arguments have been considered, but were not persuasive. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "unrefined" powder) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). The instant claims do not require that the Luo Han Guo powder be presented in the form of an 'unrefined' or unprocessed form, nor do they exclude the possibility of the powder being the end product or result of a dried sweet juice that has been extracted, such as taught by Fischer. The claims merely require a Luo Han Guo "powder". Thus, the dried powder of Fischer still meets the instant claim recitation of Luo Han Guo "powder".

Applicant argued, "The cited references neither teach nor suggest a dietary supplement that combines noni and powdered Luo Han Guo. Additionally, the cited references neither teach nor suggest the use of powdered Luo Han Guo in the ranges recited in instant claims 1, 20 and 23."

Applicant's arguments were not persuasive. The reference teachings, in combination, suggest and teach the use of noni in combination with the dried powder of Luo Han Guo. While the references do not explicitly teach the recited ranges or amounts (about 0.001 to about 3% Luo Han Guo powder) as claimed herein, the reference nonetheless recognize the use of the same components in combination to yield the same results as desired by Applicant. Moreover, Applicant has not demonstrated any superior or unexpected results that accrue from the claimed amounts. The determination of suitable or effective amounts is within the level of one of

ordinary skill in the art. The prior art would be capable of achieving beneficial results, when taken in combination, absent a showing of evidence to the contrary.

With regard to Applicant's statement traversing the suggestion by the Examiner that 'liquid and powdered extract are the same', Examiner acknowledges this traversal. It is agreed that powdered and liquid Luo Han Guo, while originating from the same source are distinct ingredients. However, the art teaches that the use of liquid as well as dried powdered forms is well-known in the art.

Applicant also traverses the suggestion that the use of powdered Luo Han Guo to mask the flavor of noni is inherent in the teachings of the cited references (Office Action, pg. 17). Applicant argues that "powdered Luo Han Guo possess properties that are not in any way inherent in liquid Luo Han Guo."

These arguments have been considered but were not persuasive. Whilst the properties between liquid and powdered Luo Han Guo may be varied, the properties desired by Applicant, such as powdered Luo Han Guo to mask the flavor and/or scent of the noni fruit and liquid Luo Han Guo to provide for a sweetening property, in any event, does not render the claims patentable. "[T]he discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art's functioning, does not render the old composition patentably new to the discoverer." *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999).

Lastly, Applicant argued, "Both Fischer and Downton teach away from the use of powdered Luo Han Guo extract. A person of ordinary skill in the art would be discouraged from using powdered Luo Han Guo based on the teachings of Fischer and Downton who specifically

state that the drying process that occurs prior to powdering causes the formation bitter, astringent and brown flavors; Fischer col. 1, lines 53-59; Downton, col. 1, lines 63-68."

This argument was not persuasive. Admittedly, the formation of bitter, astringent and brown flavors can result from the drying process as recited in the Fischer and Downton references. However, the reference also states that the drying process preserves the fruit and removes most of the objectionable flavor from the fresh fruit. The fact that the formation of bitter, astringent and brown flavors can occur, does not deter one of ordinary skill in the art from incorporating such a drying process, which is known as an effective process, routinely used for fruits from the Momordica family.

Absent any evidence to the contrary, the prior art would be capable of providing for both the sweetening as well as the flavor and/or scent masking properties, as desired by Applicant, based on the inclusion of Luo Han Guo in nutritional or supplemental compositions.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

--No claims are allowed at this time.

Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Humera N. Sheikh whose telephone number is (571) 272-0604. The examiner can normally be reached on Monday, Tuesday, Thursday and Friday during regular business hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Hartley, can be reached on (571) 272-0616. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have any questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Humera N. Sheikh/

Primary Examiner, Art Unit 1618

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